

REMARKS

In the Office Action¹, the Examiner rejected claims 27-36 under 35 U.S.C. §101; and rejected claims 1-91 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0184610 to Chong et al. ("*Chong*").

I. Regarding the rejections of claims 27-36 under 35 U.S.C. §101

The Examiner rejected claims 27-36 under 35 U.S.C. §101 because "the cited claims all detail an arrangement of data and therefore are not statutory" (Office Action at page 2). Applicants respectfully disagree.

"When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." See M.P.E.P. § 2106 (IV) p. 2100-12. A claim to a data structure stored on a computer readable medium that increases computer efficiency has been held statutory. *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Furthermore, a claim to a computer having a specific data structure stored in memory has been held statutory as a product-by-process claim. *In re Warmerdam*, 33 F.3d 1354, 1360-1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claims 27-36 are drawn to a "memory for storing data.. the memory comprising a structure...". These claims positively recite a specific data structure that is stored in memory. Therefore, claims 27-36 fall squarely within the categories of patentable

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

subject matter, and Applicants respectfully request reconsideration and withdrawal of the rejection of claims 27-36 under 35 U.S.C. §101.

II. Regarding the rejections of claims 1-91 under 35 U.S.C. §102(e) as being anticipated by *Chong*

The Examiner has not established that *Chong* is competent prior art to claims 1-91 under 35 U.S.C. § 102(e). In order to qualify as prior art within the context of 35 U.S.C. § 102(e), the “disclosure relied on in the rejection must be present in the issued patent or application publication.” M.P.E.P. § 2136.02, 8th Ed. (Rev. 2), May 2004, p. 2100-97. Further, “[t]he 35 U.S.C. [§] 102(e) critical reference date of a U.S. patent or U.S. application publications ... [is] entitled to the benefit of the filing date of a provisional application ... *if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. [§] 112, first paragraph.*” M.P.E.P. § 2136.03(III), p. 2100-99, italics added.

In this case, Applicants’ filing date of May 31, 2001 predates *Chong*’s filing date of January 18, 2002. *Chong*, however, claims priority to provisional application no. 60/263,574, filed January 22, 2001.

As M.P.E.P. § 2136.03(III) makes clear, the Examiner cannot rely on *Chong*’s priority date of January 22, 2001 to reject Applicants’ claims under 35 U.S.C. § 102(e) unless *Chong*’s provisional application no. 60/263,574 supports the invention as claimed in *Chong*. Applicants note that the Examiner did not cite the provisional application against Applicants’ claims in the Office Action. The Examiner’s choice to rely on *Chong* (which has a filing date after Applicants’ priority date), instead of the

provisional application, indicates that the provisional application may not support the subject matter relied upon by the Examiner in rejecting claims 1-91.

As set forth in 37 C.F.R. § 1.104(c), the “*pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*” It is not apparent from *Chong* which subject matter disclosed in *Chong* (if any) qualifies for the priority date of the provisional application. The Examiner should therefore explain the pertinence of this reference in rejecting claims 1-91, including whether the relied upon subject matter in *Chong* is supported by the provisional application. Because the Office Action does not clearly explain whether the relied upon subject matter in *Chong* is entitled to the priority date of the provisional application, the Office has not satisfied its burden.

Unless the Examiner provides evidence that the subject matter relied upon in *Chong* is not new matter with respect to the previous applications, *Chong* cannot be used as prior art to claims 1-91 under 35 U.S.C. § 102(e) and the rejection of these claims should be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Customer No. 22,852
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Application No.: 09/867,650


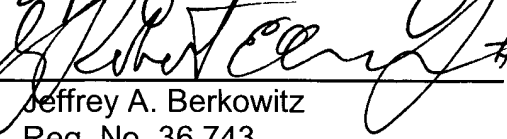
Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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